

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Nebojsa MILANOVICH <i>et al.</i>	Examiner: Meaghan E. Macpherson
Serial No.: 10/811,724	Art Unit: 3732
Filing Date: March 29, 2004	Confirmation No.: 1411
For: Dental Whitening Method	Attorney Docket No.: 7095-00

APPEAL BRIEF UNDER 37 U.S.C. § 41.35

This Appeal Brief is being submitted in response to the Notice of Appeal that was filed on November 2, 2006. This Brief is timely filed on January 3, 2007, as January 2, 2007 was a Federal holiday.

REAL PARTY IN INTEREST

The real party in interest in this appeal is Colgate-Palmolive Company by virtue of an assignment, which was recorded at Reel/ Frame: 015350/0016 on May 21, 2004.

RELATED APPEALS, INTERFERENCES, AND OTHER PROCEEDINGS

To the best of appellants' knowledge, there exist no appeals, interferences, or other proceedings that are related to this application.

STATUS OF THE CLAIMS

Claims 1-19 are pending in this application. Claims 1-19 were rejected under 35 U.S.C. §103(a). Claims 1-19 are appealed.

STATUS OF THE AMENDMENTS

No amendments were filed subsequent to the final Office Action, mailed August 2, 2006 ("Final Office Action").

SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is directed to, in independent claim 1, a method for whitening a dental surface, the method comprising nonsimultaneously applying a whitening composition to the surface, said whitening composition comprising at least one orally acceptable peroxy compound, and directing a volume of up to about 2.5 ml of an atomized activating composition on to the surface, wherein the activating composition comprises, in said volume, a peroxy compound activating effective amount of at least one orally acceptable basifying agent, and wherein applying said whitening composition and directing said activating composition are separated by an interval not greater than a peroxy compound activating effective interval (page 2, paragraph [0010]).

The present invention is also directed to, in independent claim 19, kit comprising a whitening composition that comprises at least one orally acceptable peroxy compound, and an atomizing dispensing container (having disposed therein an

atomizable activating composition that comprises, in a volume not greater than about 2.5 ml thereof, a peroxy compound activating effective amount of at least one orally acceptable basifying agent (page 2, paragraph [0014] and page 19, paragraph [0085]).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- I. Rejection under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,958,144 to Montgomery in view of United States Patent No. 5,611,690 to Summers *et al.*
 - A. Claims 1-7, 9, 10, 12-14, 17, and 19.
- II. Rejection under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,958,144 to Montgomery in view of United States Patent No. 5,611,690 to Summers *et al.* and further in view of United States Patent No. 5,648,064 to Gaffar *et al.*
 - A. Claims 8, 11, and 18.
- III. Rejection under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,958,144 to Montgomery in view of United States Patent No. 5,611,690 to Summers *et al.* and further in view of United States Patent No. 6,485,709 to Banerjee *et al.*
 - A. Claims 15 and 16.

ARGUMENT

- I. Rejection of claims 1-7, 9, 10, 12-14, 17, and 19 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. United States Patent No. 6,958,144 to Montgomery in view of United States Patent No. 5,611,690 to Summers *et al.*

Summers '690 discloses a tooth whitening bleach that is sprayed onto teeth (Abstract). The combination of Summers '690 with Montgomery '144 would require the tooth bleaching composition of Montgomery '144 to also be sprayed. The claimed method directs an atomized activating composition onto a dental surface (independent claim 1) or provides the activating composition in an atomizing dispenser (independent

claim 19). There is no disclosure or suggestion in Summers '690 of using the spray bottle to spray materials such as an activating composition.

Additionally, there is no disclosure or suggestion in Montgomery '144 or Summers '690 of selecting all of the elements of the claimed method in the combination that is claimed without the need for picking and choosing from among all of the possibilities for combinations that might result from the disclosures in Montgomery '144 and Summers '690.

In order to anticipate a composition when a reference discloses multiple variables and combinations, the reference must describe the composition with enough detail such that the composition is in the possession of the public. *In re Brown*, 329 F. 2d 1006, 1011, 141 U.S.P.Q. 245, 249 (C.C.P.A. 1964). Also, the reference must clearly and unequivocally disclose the composition or direct those skilled in the art to the composition without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the reference. *In re Arkley*, 455 F.2d 586, 587, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972). Additionally, under the obviousness standard, while it may be obvious to try to vary all parameters or try each of numerous possible choices, the reference must suggest the combination and selection of parameters for the composition. *In re O'Farrell*, 853 F.2d 894, 903, 7 U.S.P.Q.2d 1673, 1681 (Fed. Cir. 1988).

There is no motivation to select application of the activating composition via atomization and to select the volume of the activating composition to be an amount up to about 2.5 ml in combination with all of the other elements of the claimed method in independent claim 1. Similarly in independent claim 19, there is no motivation to provide the activating composition in an atomizing dispenser that dispenses in an amount not greater than about 2.5 ml in combination with all of the other claimed elements of the kit. The references lack the disclosure to put the claimed method or kit with all of the claimed elements in the claimed combination in the possession of the public.

Because there is no disclosure or suggestion of directing an atomized activating composition onto a dental surface or providing an activating composition in an atomizing dispenser in combination with all of the other elements of the independent claims, it is respectfully submitted that claims 1-7, 9, 10, 12-14, 17, and 19 are patentable over United

States Patent No. 6,958,144 to Montgomery in view of United States Patent No. 5,611,690 to Summers *et al.*

- II. Rejection of claims 8, 11, and 18 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,958,144 to Montgomery in view of United States Patent No. 5,611,690 to Summers *et al.* and further in view of United States Patent No. 5,648,064 to Gaffar *et al.*

Claims 8 and 11 depend from independent claim 1 and claim 18 ultimately depends from independent claim 1. From above, independent claim 1 is patentable over the cited references. When an independent claim is patentable, claims that depend from the independent claim are also patentable. Therefore, it is respectfully submitted that claims 8, 11, and 18 are patentable over the cited references.

- III. Rejection of claims 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,958,144 to Montgomery in view of United States Patent No. 5,611,690 to Summers *et al.* and further in view of United States Patent No. 6,485,709 to Banerjee *et al.*

Claims 15 and 16 ultimately depend from independent claim 1. From above, independent claim 1 is patentable over the cited references. When an independent claim is patentable, claims that depend from the independent claim are also patentable. Therefore, it is respectfully submitted that claims 15 and 16 are patentable over the cited references.

FOR THESE REASONS, Applicants respectfully petition this Honorable Board to reverse the rejection set forth by the Examiner. Should the Board have any questions about the above remarks, the undersigned attorney would welcome a telephone call.

Respectfully submitted,
Milanovich *et al.*

/Michael F. Morgan/

Date: January 3, 2007

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Enclosure: Claims Appendix (3 pages)
Evidence Appendix (1 page)
Related Proceedings Appendix (1 page)

CLAIMS APPENDIX

1. (Original) A method for whitening a dental surface, the method comprising nonsimultaneously applying a whitening composition to the surface, said whitening composition comprising at least one orally acceptable peroxy compound, and directing a volume of up to about 2.5 ml of an atomized activating composition on to the surface, wherein the activating composition comprises, in said volume, a peroxy compound activating effective amount of at least one orally acceptable basifying agent, and wherein applying said whitening composition and directing said activating composition are separated by an interval not greater than a peroxy compound activating effective interval.
2. (Original) The method of claim 1 wherein the activating composition raises pH in the immediate environment of the dental surface to a value of at least about 7.
3. (Original) The method of claim 1 wherein applying said whitening composition and directing said activating composition are separated by an interval not greater than about 1 hour.
4. (Original) The method of claim 1 wherein said directing of the atomized activating composition on to the dental surface precedes said applying of the whitening composition to the surface.
5. (Original) The method of claim 4 wherein said directing of the atomized activating composition substantially immediately precedes said applying of the whitening composition.

6. (Original) The method of claim 1 wherein said directing of the atomized activating composition on to the dental surface follows said applying of the whitening composition to the surface.
7. (Original) The method of claim 6 wherein said directing of the atomized activating composition substantially immediately follows said applying of the whitening composition.
8. (Original) The method of claim 1 wherein the whitening composition is selected from the group consisting of mouthwashes, dentifrices, oral strips, liquid whiteners and chewing gums.
9. (Original) The method of claim 1 wherein the at least one peroxy compound is selected from the group consisting of hydrogen peroxide, peroxides of alkali and alkaline earth metals, organic peroxy compounds, peroxy acids and salts thereof, and polymer-peroxide complexes.
10. (Original) The method of claim 1 wherein the at least one peroxy compound is hydrogen peroxide.
11. (Original) The method of claim 1 wherein the whitening composition comprises at least one peroxy compound in a total hydrogen peroxide equivalent amount of about 0.1% to about 10% by weight.
12. (Original) The method of claim 1 wherein the activating composition is directed on to the dental surface in a volume of about 25 μ l to about 1 ml.
13. (Original) The method of claim 1 wherein the activating composition is a liquid comprising the basifying agent in aqueous solution.

14. (Original) The method of claim 13 wherein the at least one basifying agent is an alkali metal carbonate or bicarbonate salt.
15. (Original) The method of claim 13 wherein the at least one basifying agent is sodium bicarbonate.
16. (Original) The method of claim 15 wherein the activating composition comprises about 0.5% to about 20% by weight sodium bicarbonate.
17. (Original) The method of claim 13 wherein the activating composition has a pH of about 8 to about 12.
18. (Original) The method of claim 13 wherein the activating composition further comprises at least one ingredient selected from the group consisting of cosolvents, mouth feel modifying agents, surfactants, preservatives, sweeteners, flavorants and colorants.
19. (Previously Presented) A kit useful for whitening a dental surface, the kit comprising a whitening composition that comprises at least one orally acceptable peroxy compound, and an atomizing dispensing container having disposed therein an atomizable activating composition that comprises, in a volume not greater than about 2.5 ml thereof, a peroxy compound activating effective amount of at least one orally acceptable basifying agent.

EVIDENCE APPENDIX

There is no evidence submitted with this Appeal Brief.

RELATED PROCEEDINGS APPENDIX

There are no decisions rendered by a court or the Board submitted with this Appeal Brief.